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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/695,686

10/29/2003

Margaret Aleles

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PHILIP S. JOHNSON
JOHNSON & JOHNSON
ONE JOHNSON & JOHNSON PLAZA
NEW BRUNSWICK, NJ 08933-7003

EXAMINER

PORTER, RACHEL L

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/695,686	Applicant(s) ALELES ET AL.	
	Examiner RACHEL L. PORTER	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the application filed 10/29/03. Claims 1-26 are pending.

Information Disclosure Statement

2. The IDS filed 10/30/06 has been considered by the Examiner.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a §101 process must (1) be tied to a machine or apparatus or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and should be rejected as being directed to nonstatutory subject matter.

It has also been held that the involvement of the machine-or-transformation should not be nominal: “[T]he involvement of the machine or transformation in the claimed process must not merely be insignificant extra-solution activity.” *In re Bilski*, 88 USPQ2d 1385, 1396 (Fed. Cir. 2008) Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. (See *Gottschalk v. Benson*, 409 U.S. at 71-72.)

Claims 1,6,7, and 15 fails to recite the required tie to a specific machine or apparatus to perform the recited steps. Therefore, the claimed methods are considered to be nonstatutory subject matter.

Dependent claims 2-5,8-14, and 16-26 contain similar deficiencies and also fail to correct the deficiencies of claims 1,7, and 15 respectively. Therefore, claims 2-5,8-14, and 16-26 are also rejected.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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5. Claims 1-23 are rejected under 35 U.S.C. 102(a,e) as being anticipated by Peyrelevade US (2003/0065636A1)

[claim 1] Peyrelevade discloses a method of providing an individualized hair care program to a customer, the method comprising, in a first retail location: a) obtaining personal information from a customer; (Figure 1A(100)) b) using the personal information to create an individualized hair care program for the customer(Figure 1A, par. 38,40); c) providing the individualized hair care program to the customer, wherein the individualized hair care program comprises at least two elements selected from the group consisting of a recommendation for at least one hair care product, a recommendation for at least one hair care activity, and a recommendation for at least one hair care service; (Figure 17; par. 67, 90-93) d) wherein the first retail location is one of a plurality of retail locations in data communication with one another. (Figure 4; pars. 51,143)

[claim 2] Peyrelevade discloses the method of claim 1 wherein data comprising the personal information is communicated from the first retail location to a second retail location. (Figure 4, par. 51, merchant nodes may access user profile info. via the network)

[claim 3] Peyrelevade discloses the method of claim 1 wherein data comprising the individualized hair care program is communicated from the first retail location to a second retail location.(Figure 4, par. 51 multiple merchant nodes in communication via the network; par. 56-- merchants may also provide the user with an option to affirmatively seek a recommendation of one or more products)

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[claim 4] Peyrelevade discloses the method of claim 1 wherein data comprising the personal information and the individualized hair care program are communicated from the first retail location to a second retail location. .(Figure 4, par. 51 multiple merchant nodes in communication via the network; par. 56-- merchants may also provide the user with an option to affirmatively seek a recommendation of one or more products)

[claim 5] Peyrelevade discloses the method of claim 4 wherein the data comprising the personal information and the individualized hair care program are communicated from the first retail location to the second retail location at the customer's direction. (par. 54-- user profile database 430 may be kept separate, for privacy purposes is user desires)

[claim 6] Peyrelevade discloses a method of providing an individualized hair care program to a customer in a retail shopping environment, the method comprising, in a retail shopping environment: a) obtaining personal information comprising objective information from a customer;(Figure 1A) b) using the personal information to generate individualized hair care needs for the customer; (par. 38,40) (c) evaluating the individualized hair care needs against standards that reflect needs for hair care products, needs for hair care services, and needs for hair care activities, to create an individualized hair care needs assessment; (Figures 6-7; par. 67-67) d) using the individualized hair care needs assessment to create an individualized hair care program, the individualized hair care program comprising at least one element selected from the group consisting of a hair care product, a hair care service, and a hair care activity; (Figure 7; par 65) and e) providing the individualized hair care program to the

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customer. (par. par. 67, 90-93)

[claim 7] Peyrelevade discloses a method of providing a personalized hair care program to a customer in a retail shopping environment, the method comprising: a) obtaining personal information comprising objective information from a customer; (Figure 1A b) using the personal information to create a personalized hair care program for the customer (par. 38,40); c) providing the personalized hair care program to the customer, wherein the personalized hair care program comprises at least two elements selected from the group consisting of a recommendation for at least one hair care product, a recommendation for at least one hair care activity, and a recommendation for at least one hair care service. (par. par. 67, 90-93, 152-154)

[claim 8] Peyrelevade discloses the method of claim 7 wherein the personal information is retained with a personal identifier unique to the customer. (Figure 16: user profile with name)

[claim 9] Peyrelevade discloses the method of claim 7 wherein the personal information comprises subjective information. (Figure 16: e.g. preferred brands)

[claims 10-12] Peyrelevade discloses a method of claim 9 wherein the subjective personal information is obtained from the customer by questioning means, including an interview or a written questionnaire. (Figure 16)

[claim 13] Peyrelevade discloses the method of claim of claim 7 wherein the hair care activity is an educational seminar.(par. 152-154)

[claim 14] Peyrelevade discloses the method of claim 7 wherein the hair care activity is a recommendation for the customer to be examined by a dermatologist. (par. 152-

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154—e.g. skin care professional)

[claim 15] Peyrelevade discloses a method of providing a personalized hair care program to a customer in a retail shopping environment, the method comprising a) obtaining personal information from a customer (Figure 1A); b) objectively evaluating a portion of the customer's hair to create a hair measurement; (Figure 16, par. 145—evaluation of hair includes length and other hair measurements) c) analyzing the hair measurement to create a hair analysis report; (Figure 16, par. 145—evaluation of hair includes length) d) providing a professional evaluation of the customer's hair by a professional hair care consultant; (Figure 7; par. 65) e) using the personal information, the professional evaluation, and the hair analysis report to create a personalized hair care program for the customer; (Figure 17; par. 67, 90-93) and f) providing the personalized hair care program to the customer, wherein the hair care program comprises recommendations for at least one hair care product, at least one hair care activity, and at least one hair care service. (Figure 17; par. 67, 90-93)

[claim 16] Peyrelevade discloses the method of claim 15 wherein the personalized hair care program is provided to the customer through one or more hair care counseling sessions with a professional hair care consultant. (par. 90-93;145;151-154—therapy external body conditions including hair, performed by a professional)

[claim 17] Peyrelevade discloses the method of claim 15 wherein the personalized hair care program is provided to the customer through a written report. (Figures 17 and 21)

[claim 18] Peyrelevade discloses the method of claim 15 wherein the at least one

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hair care activity is selected from the group consisting of educational seminars, an appointment with a doctor, a stress reduction program, and support groups. (par. 67, 90-93; 151-154)

[claim 19] Peyrelevade discloses the method of claim 15 wherein the at least one hair care product is selected from the group consisting of shampoos, conditioners, styling aids, hair sprays, hair straightening products, hair mascara, hair extensions, hair pieces, depilatories, hair removal waxes, essential oils, scalp/hair treatment oils, hair growth products, oral supplements, hair texturizers, hair sunblock, hair towels, and hair loss prevention products. (par. 152-154)

[claim 20] Peyrelevade discloses the method of claim 15 wherein the at least one hair care service is selected from the group consisting of washing, styling, permanent waving; hair straightening; hair coloring; hair cutting; scalp, head and neck massage; deep conditioning; baldness treatments; hair follicle induction or transplantation; hair weaving; hair transplants; shaving; laser hair removal; hair waxing; personalized hair color analysis; personalized hair style analysis; scalp treatments; hair growth treatments; email or postcard reminders for hair services; and special occasion hair styling. (par. 151-154; par. 145)

[claim 21] Peyrelevade discloses the method of claim 15 wherein the personal information includes subjective information. (Figure 16: e.g. preferred brands; par. 160-161)

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[claim 22] Peyrelevade discloses the method of claim 15 wherein the personalized hair care program comprises a recommendation for the customer to be examined by a physician. (par. 152-154—e.g. skin care professional)

[claim 23] Peyrelevade discloses the method of claim 15 wherein at least one of the personal information, the hair measurement, the assessment, and the hair analysis report is retained with a personal identifier unique to the customer. (Figure 16: user profile with name)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peyrelevade as applied to claim 15 in view of Pruche et al (US 2003/0065523A1).

[claims 24-26] Peyrelevade discloses the method of claim 23, but does not expressly disclose tracking the individual's progress following a beauty/hair regimen.

Pruche discloses a method wherein the portion of the customer's hair is evaluated to create a first hair measurement at a first time, and a portion of the customer's hair is measured to create a second hair measurement at a second time which is later than the first time. (par. 71-73) Pruche discloses that the personalized

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hair care program further comprises a comparison of the first hair measurement and the second hair measurement and that a personal identifier is used to retrieve the first hair measurement. (Figure 7; par.43, 69-73). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the method of Peyrelevade the teachings of Pruche to track user progress under a regimen. As suggested by Pruche, one would have been motivated to include this feature to encourage sustained use to better determine the effectiveness of treatments. (par. 0004-0006)

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Rubinstenn: US 2003/0065588A1.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RACHEL L. PORTER whose telephone number is (571)272-6775. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, (Christopher) Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/R. L. P./
Examiner, Art Unit 3626

/Robert Morgan/
Primary Examiner, Art Unit 3626